



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

08/487,032

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

08/487,032 08/26/95 CROFT

LANIVE AND COCKFIELD  
33 STATE STREET  
BOSTON MA 02109

EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 6/7/95

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-6 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/487,032	06/07/95	SMITH	D GTN-001

LAHIVE AND COCKFIELD  
28 STATE STREET  
BOSTON MA 02109

18M1/0121

EXAMINER	
PORTNER, V	
ART UNIT	PAPER NUMBER
1802	

DATE MAILED: 01/21/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Art Unit: 1802

### **DETAILED ACTION**

Claims 1-6 are pending in the instant Application.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3-6 are, drawn to various proteins, classified in class 530, subclass 350.
  - II. Claim 2 is, drawn to isolated nucleic acid molecules, classified in class 536, subclass 23.1.
2. The invention of group I is distinct from the invention of group II because it is drawn to materially different compositions that require non-coextensive areas of search and consideration. For example, the proteins of the invention of Group I may be isolated from natural sources and are not necessarily defined by the DNAs that encode them.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification, recognized divergent subject matter, and because the searches required for the separate groups of inventions are non-coextensive, restriction for examination purposes as indicated is proper.
4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1802

5. Claims 1, 3-6 are to a plurality of disclosed patentably distinct products comprising materially different proteins. Should the inventions of Group I be elected, Applicant would be required under 35 U.S.C. 121 to elect a single disclosed product, even though this requirement is traversed. The separate proteins bear no structural or biochemical property in common and therefore each particular protein product claimed and would require a separate area of search and consideration tailored to the particular product under consideration.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In addition to the preceding restriction requirement, upon the election of Group II, the following additional election would be required:

Claim 2 is drawn to isolated nucleic acid molecules that contain more than ten individual, independent and distinct nucleotide sequences in alternative form. Accordingly, this claim is subject to restriction under 35 U.S.C. 121 as outlined in 1192 O.G. 68 (Nov. 19, 1996).

Applicant is required to select no more than ten of the individual sequences for examination. The search of no more than ten selected sequences may include the complements of the selected sequences and, where appropriate, may include sequences within the selected sequences (e.g. oligomeric probes and/or primers).

Art Unit: 1802

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this group is (703) 305-7939.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [James.Housel@uspto.gov].

All internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official

Serial Number: 08/487,032

Page 5


Art Unit: 1802

Gazette of the Patent and Trademark on February 25, 1997 at 1195  
OG 89.

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703) 308-0196.

VGP

January 14, 1998

  
JAMES C. HOUSEL 1/20/98  
SUPERVISORY PATENT EXAMINER  
GROUP 180